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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,713	11/14/2003	Takeya Okamoto	ADACHI P134USD3	2096
20210	7590	08/11/2004	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151			CHENG, JOE H	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,713

Applicant(s)

OKAMOTO, TAKEYA

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26, 27, 29, 30 and 32 is/are rejected.
- 7) ☒ Claim(s) 25, 28 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/14/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/232,862.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14/03 and 2/2/0.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. In response to the Preliminary Amendment filed on November 14, 2003, claims 1-21 have been cancelled and the newly added claims 22-32 are pending.

Specification

2. The disclosure is objected to because of the following informalities: The term "This is a Divisional of U.S. Application Ser. No. 10/307,886 filed December 2, 2002 which is a Divisional of U.S. Application Ser. No. 09/733,541, filed December 8, 2000, now U.S. Patent No. 6,488,508 B2, which is a Divisional of U.S. Patent Application Serial No. 09/109,784, filed July 2, 1998, now U.S. Patent No. 6,193,520 B1, which is a Continuation-in-Part of U.S. Patent Application Serial No. 08/642,560, filed May 3, 1996, now U.S. Patent No. 5,775,995, which is a Divisional of 08/555,400, filed November 9, 1995, now U.S. Patent No. 5,735,744, which is a Continuation-in-Part of U.S. Patent Serial No. 08/232,862, filed April 24, 1994, now U.S. Patent No. 5,489,103." on Pg. 1, lines 5 and 6 should be recited as -- This is a Divisional of U.S. Application Serial No. 10/307,886, filed December 2, 2002, now U.S. Patent No. 6,702,585 B2, which is a Divisional of U.S. Application Serial No. 09/733,541, filed December 8, 2000, now U.S. Patent No. 6,488,508 B2, which is a Divisional of U.S. Patent Application Serial No. 09/109,784, filed July 2, 1998, now U.S. Patent No. 6,193,520 B1, which is a Continuation-in-Part of U.S. Patent Application Serial No. 08/642,560, filed May 3, 1996, now U.S. Patent No. 5,775,995, which is a Divisional of 08/555,400, filed November 9, 1995, now U.S. Patent No. 5,735,744, which is a Continuation-in-Part of U.S. Patent Serial No. 08/232,862, filed April 24,

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1994, now U.S. Patent No. 5,489,103.--, so as to clarify the status. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 22-24, 26, 27, 29, 30 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,488,508 B2 (hereinafter as Okamoto). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of “a transmitter device for transmitting the program, the data, or the combination of the program and data at the request of said communication terminal devices to said communication terminal device” (as per claims 22, 26 and 29), “a charging device for charging a fee for at least one use of the transmitted program, the data, or the combination of the program and data in said communication terminal device” (as per claim 22), “ the charging device charges a fee per each use of the transmitted program, the data, or the combination of the program and data in said communication terminal device” (as per claim 23), “ the charging device automatically charges a fee per each use of the transmitted program, the data, or the combination of the program and data in said communication terminal device” (as per claim 24), “a charging device for charging a fee for a specified time for use of at least one program, data, or combination of program and data in said communication terminal device” (as per claim 26), “ the charging device automatically charges a fee for a specified time for use of the transmitted program, the data, or the combination of the program and data in said communication terminal

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device” (as per claim 27), “a charging device for charging a fee for at least one transmitted program, data, or combination of program and data to said communication terminal device” (as per claim 29), “the charging device automatically charges a fee for the transmitted program, the data, or the combination of the program and data in said communication terminal device” (as per claim 30) and “the charging device charges a fee for unlimited use of program, data, or the combination of program and data to said communication terminal device within a specified time period” (as per claim 32) are the obvious alternative languages since these merely describe the “means for transmitting the program, the data, or the combination of the program and data at the request of said communication terminal device to said communication terminal device”, “means for charging a use fee on the use of the transmitted program, the data, or the combination of the program and data in said communication terminal device and for direct debit against an account in a banking system” (as per claim 1 of Okamoto) and said charging of the use is varied in accordance with the newness of the program, the data, and the combination of the program and data” (as per claim 2 of Okamoto) in boarder terms. Hence, the instant claim does not differ from the scope of the patented claims 1-4. In 214 USPQ 761, *In re Van Ornum and Stang*, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

Allowable Subject Matter

6. Claims 25, 28 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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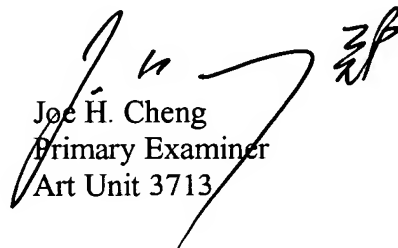
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
July 27, 2004


Joe H. Cheng
Primary Examiner
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